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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,515	01/21/2000	Surya Prakash	06618-408001	5938

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EXAMINER	
MERCADO, JULIAN A	
ART UNIT	**PAPER NUMBER**
1745	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/489,515	PRAKASH ET AL.	
	Examiner	Art Unit	
	Julian Mercado	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-22,24-27 and 29-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-22, 24-27 and 29-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Remarks

This Office action is responsive to applicant's amendment filed January 6, 2006.

Claims 19-22, 24-27 and 29-33 are pending.

Claim Rejections - 35 USC § 102 and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Prakash et al. (U.S. Pat. 6,444,343 B1)

The rejection is maintained for the reasons of record. As in the prior Office action, the product-by-process limitations of the providing, applying and bonding of a catalyst ink have not given patentable weight as the limitations do not give breadth or scope to the product claim.

Applicant submits that by the present amendment, now reciting the step of adding to the catalyst ink a second ionomer comprising a liquid copolymer of tetrafluoroethylene and perfluorovinylethersulfonic acid, the claimed final material is not the same. This argument is not persuasive. Notwithstanding that this feature is a product-by-process limitation, Prakash teaches addition of Nafion H, which is a derivate of tetrafluoroethylene and perfluorovinylethersulfonic acid. See col. 8 line 49 et seq.

Claims 19, 20, 25-27, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grot et al. (U.S. Pat. 5,919,583) in view of Fleisher et al. (U.S. Pat. 5,643,689) and Kindler (U.S. Pat. 5,992,008).

The rejection is maintained for the reasons of record. New claims 32 and 33 are deemed taught or at least suggested by the prior art insofar as providing poly(vinylidene) fluoride in powder form merely requires providing this material as received from its manufacturer. The examiner notes the present amendment to the claims (as highlighted above), which appears to be features as previously recited in dependent claim 23 (now canceled).

As discussed in a prior Office action, while Grot et al. does not explicitly teach the claimed second ionomer, Kindler teaches this ionomer as a liquid copolymer. See Kindler at col. 3 line 36-38 and col. 6 line 28 et seq. It is maintained that modification of Grot et al. by employing the disclosed second ionomer would have been obvious at least to the skilled artisan for reasons such as improving wetting properties and ionic continuity, *inter alia*. See Kindler at col. 4 line 10 et seq.

- Applicant's arguments have been fully considered, however they are not found persuasive. Applicant submits that no reference teaches both of the first and second ionomers. In reply, applicant is reminded the present ground of rejection is made based on a combined obviousness-type teaching by the prior art, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is noted that applicant submits that "a person having ordinary skill in the art might well conclude that the two separate additives are merely duplicative of one another." This is not persuasive; applicant is reminded that attorney arguments are not evidence and cannot take place of evidence in the record; an assertion of what the artisan "*might* well conclude" is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness. (emphasis added) See MPEP 2145.

Claims 21, 22, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grot et al. in view of Fleisher et al. and Kindler, and further in view of Cabasso et al. (U.S. Pat. 5,783,325).

Claims 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grot et al. in view of Fleisher et al. and Kindler, and further in view of Lawrance et al. (U.S. Pat. 4,272,353).

In maintaining each of these grounds of rejection for the reasons of record, the examiner notes that no salient arguments against Cabasso et al., Kindler and Lawrance et al. were submitted with the present amendment.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jam

PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER